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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,286	11/30/2001	Eric Acets	9971-005	2124
20583	7590	12/30/2005	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			TORRES VELAZQUEZ, NORCA LIZ	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 12/30/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,286

Applicant(s)

AERTS, ERIC

Examiner

Norca L. Torres-Velazquez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) 48-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed September 26 and September 29, 2005 have been fully considered but they are not persuasive.

- a. With regards to Applicant's arguments indicating that the cited prior art is either insufficient to provide all the limitations of the claimed invention or to provide the required motivation to combine the cited art, it is noted herein that while Battreall discloses the use of polyamides as preferred materials for the heat activated adhesive, the use of other preferred activated adhesives such as polyolefins and polyurethanes cannot be ignored. It is the Examiner's interpretation that the disclosure does teach the use of polyurethane adhesives in the form of a liquid, a powder, a film or web. (Col. 2, lines 33-36) The Examiner has applied the SMITH reference as a primary reference that discloses a laminate structure similar to the present invention but it fails to teach that the adhesive is a polyurethane film. The reference teaches the use of a web of an open net-like film. The Examiner has relied upon the BATTREALL reference to provide a polyurethane film as an equivalent structure. With regards to the thickness of the adhesive layer, it is noted that the Examiner has provided evidence that the claimed thickness encompass typical values found in the prior art. It is finally noted that the prior art of record is also directed to fabric laminates that are analogous to the present invention and the rejections provide motivation for the combination of the references applied. With regards to the
- b. It is clarified herein that claims 48-73 have not been rejoined and they remain as withdrawn claims. Refer to last office action.

c. Applicants have provided copy of a recent decision of the BPAI and cites *In re Lee*; however, it is not explained how the submitted documentation is relevant to the prosecution of the present case. It is reinstated herein that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983).

d. Applicants have amended independent claim 1 to new recite that the thickness of the film is less than about 20 mils. It is noted that the PRUNESTI et al. reference provided as evidence to show that the claimed thickness is a typical thickness for adhesives in garment materials. With regards to arguments indicating that PRUNESTI et al. refers to powder adhesives, it is noted herein that the thickness disclosed in Col. 9, lines 44-62 is that of the adhesive material after heat setting, which is no longer in powder form. It is further provided as evidence herein the prior art of HAIGH (US 3,657,060) that discloses a laminate fabric that comprises a fabric base laminated to a thermoplastic material and then is fastened to a garment by heat and pressure. The thermoplastic material comprises polyurethane and is about 10 mils thick. (Refer to claims).

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-14, 27, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over SMITH et al. (US 5,447,462) in view of BATTREALL (US 5,234,523) and further evidenced by PRUNESTI (US 4,776,916) and/or HAIGH (3,657,060).

Smith is concerned with the creation of a laminated fabric used in the construction of a brassiere. Smith teaches two fabrics laminated together by an open net-like film of heat sensitive adhesive. (Abstract) The fabrics are laminated by using heat and pressure. (Refer to Column 9) The reference teaches the fabric to have a cup. (Figure 13). Smith teaches applicant's claimed openings. (Figure 11) Smith further teaches the use of additional layers laminated in the same manner as the first two layers (Col. 5, lines 18-25). The reference further teaches the fabrics to be elastic and woven. (Col. 5, lines 24-34)

The Smith reference provides the fabric laminate structure of claim 1 that comprises a first fabric, a second fabric and a heat sensitive adhesive layer in between. However, it fails to teach a film (different from a web of an open net-like film) that comprises polyurethane.

BATTREALL discloses a process for laminating a layer of material to a substrate used of contoured products. (Col. 1, lines 8-13) The reference teaches laminating a substrate (made from materials such as cotton), to a gas permeable layer (knitted or woven material) by means of an adhesive layer. The adhesive may be in the form of a liquid, a powder, a film or a web, and may be applied to the substrate surface in any of the conventional methods for doing so. The

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reference discloses the use of heat-activated adhesives such as polyolefins, polyesters, polyurethane, etc. (Col. 2, lines 14-55) With regards to the thickness of the adhesive layer, it is noted that the BATTRELL reference discloses that the amounts of adhesive will vary depending on the physical characteristics of the material to be bonded. (Col. 2, lines 49-52 Applicant's ranges for the limitation of the thickness of the adhesive layer are broad and encompass typical values that are found in the prior art. Further each of the elements are recognized as result effective variables in this field of endeavor and it has been held that discovering optimum values would have been or result effective variables involves only routine experimentation. This is evidenced by the PRUNESTI et al. (US 4,776,916) reference, which uses adhesive materials garments with typical thickness values for garments in which the thickness of the adhesive material varies depending on the amount of support intended. The reference teaches thicknesses of 0.013-0.016 inches [13-16 mils] of the adhesive after heat setting. (Refer to Col. 9, lines 44-62) HAIGH discloses a laminate fabric that comprises a fabric base laminated to a thermoplastic material and then is fastened to a garment by heat and pressure. The thermoplastic material comprises polyurethane and is about 10 mils thick. (Refer to claims)

Since both SMITH and BATTRELL et al. are directed to laminates, the purpose disclosed by BATTRELL et al. would have been recognized in the pertinent art of SMITH.

SMITH discloses the claimed invention except that it uses a polyamide heat sensitive web of an open net-like film instead of a polyurethane heat sensitive adhesive film, BATTRELL shows that polyurethane film is an equivalent structure known in the art. Therefore, because these two references were art-recognized equivalents at the time the invention was made, one of

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ordinary skill in the art would have found it obvious to substitute a polyamide web of an open net-like film for a polyurethane film.

It is the examiner's position that the laminate from the combination of SMITH and BATTREALL is identical to or only slightly different than the laminate claimed prepared by the method of the claim(s), because both laminates are formed by two layers of fabric bonded by a polyurethane film adhesive in between. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). The SMITH in view of BATTRELL either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the prior art applied herein.

4. Claims 15-24 and 35-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over SMITH et al. (US 5,447,462) and BATTREALL (US 5,234,523) and further evidenced by RUDY (US 5,042,176).

While BATTREALL is silent to the type of polyurethane material used, the use of an ether-based polyurethane film would have been obvious since this type of material is known for its hydrolysis stability as evidenced by RUDY (Col. 13, lines 24-52) and one having ordinary skill in the art of polyurethane film materials would use an ether-based polyurethane film in the production of materials that are highly exposed to water and moisture motivated by the desire of producing a material that is stable in water and moisture environments.

5. Claim 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and BATTREALL as applied above, and further in view of Kollmanthaler et al. (US 5,967,876).

Smith fails to teach the use of an insert wire. Kollmanthaler is concerned with the creation of a brassiere. Kollmanthaler teaches the use of an insert wire. (Abstract) It would have been obvious to a person having ordinary skill in the art to utilize an insert wire in the bra of Smith. Such a combination would have been motivated by the desire to provide further support to the wearer of the garment, for example, the use of insert wires will be useful in enhancing the support the brassiere for a wearer with full figure. It is the Examiner's position that the use of an insert wire to provide an enhanced support would be recognized in the art of Smith.

6. Claims 28-31 and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and BATTREALL as applied above, and further in view of Tedeschi et al. (US 5,984,762).

Smith teaches the use of a strap but fails to teach cushioning said strap. Tedeschi is concerned with the creation of a bra strap. Tedeschi teaches applicant's claimed cushioning layers. (Abstract).

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With respect to the process limitations of prelaminating the adhesive, it is the Examiner's position that the laminate fabric and brassiere created by the combination of Smith and Tedeschi is identical to or only slightly different than the presently claimed laminate and brassiere prepared by the method of the claim(s), because both structures have a first fabric laminated to a second fabric by an adhesive in between. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983).

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 571-272-1484. The examiner can normally be reached on Monday-Thursday 8:00-5:00 pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Norca L. Torres-Velazquez
Primary Examiner
Art Unit 1771

December 22, 2005